



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,910	11/08/2000	Edward J. Walters	26495.101.US02	9069

26853 7590 06/09/2004

COVINGTON & BURLING  
ATTN: PATENT DOCKETING  
1201 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20004-2401

EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
----------	--------------

2177

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/707,910

Applicant(s)

WALTERS ET AL.

Examiner

Greta L. Robinson

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-24, 26-30, 34-67, 71, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-24, 26-30, 34-67, 71, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

Art Unit: 2177

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2004 has been entered.
2. Claims 1-4, 6-24, 26-30, 34-67, 71 and 74-75 are pending in the present application.
3. Claims 1, 2, 4, 12, 16, 21, 22, 24, 40, 45, 56, 57, 60 and 61 have been amended.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 2, 6-15, 22, 23, 26-30, 34, 40-49, 58, 59 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2177

Regarding **claims 2, 4, 6, 7, 22, 23, 26 and 34**, the following limitation is vague and lacks proper antecedent basis: "said responsive records" [note claim 2 line 2; claim 6 line 1-3; claim 7 line 1; claim 22 line 2; claim 23 lines 1-2; claim 26 lines 1-2; claim 34 line 2]. Claims 8, 15, 58, 9-14, 59, 27-30, 71 are rejected based on dependency.

Regarding **claims 40 and 45**, the following limitation lacks proper antecedent basis: "said list of responsive records" [note claim 40 line 2; claim 45 line 2]. Claims 41-44 and 46-49 are rejected based on dependency.

Regarding **claim 15**, the meaning of the term "resolving ties" is vague. The meaning of the term is not clear; support for the limitation within the disclosure should be cited.

Regarding **claim 16**, the term responsive records is vague. Claims 17-20 are rejected based on dependency.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2177

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 6-15, 21-24, 26-30, 34-39, 50-67, 71 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. US Patent 5,873,076 in view of Jones et al. US Patent 6,415,307 B2

Regarding claim 1, **Barr et al.** teaches a method for displaying records responsive to a database query wherein the records are characterized by having identifiers and content elements [note: query server 116, figure 3] comprising the steps of:

displaying a list of identifiers for at least two of said records [note: element 204 figure 2]; and

Art Unit: 2177

displaying simultaneously content elements of at least one of the records [note: column 14 lines 29-51 "*software 106 display the search result list (or a portion thereof), together wit (i) relevance scores ... bibliographical information corresponding to each document*"; element 206 figure 2; figures 4A and 5; col. 12 lines 48-57; col. 14 lines 29-65].

Although Barr et al. teaches the invention substantially as cited above, they do not explicitly disclose simultaneous display of said list of identifiers and content elements. Bar et al. teaches simultaneously identifying document records with a single search query [column 4 lines 11-14]. **Jones et al.** teaches a user interface with a retrieval result display unit for *simultaneous display* of results of a database query [see: abstract; figure 2 and 10; column 6 lines 20-50]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Jones et al. with Barr et al. because Jones et al's ability to simultaneously display a list of items and there content would provide the user with better viewing of the retrieval result and it's equivalent content.

8. Regarding claims 2-4:

(Claim 2) wherein said displayed content elements comprise the entirety of one of said responsive records [Barr et al., Figure 4A and 5].

Art Unit: 2177

(Claim 3) wherein said identifiers comprise case citations [Barr et al., figure 4A and 5].

(Claim 4) further comprising the step of identifying and marking records displayed in their entirety in a prior database query [Barr et al., 206 figure 2 and figure 4A].

9. Regarding claims 6, 8, and 15 note Barr et al.:

(Claim 6) further comprising the step of sorting said responsive records [col. 13 lines 30-67].

(Claim 8) wherein said responsive records include a record name;

a record citation; a record date; and a record author [note element 400 figure 5].

(Claim 15) further comprising the step of resolving ties in a preceding sort [col. 13 lines 30-67].

10. Regarding claim 7 note Barr et al.:

further comprising the step of computing the relevance of said responsive records [col. 13 lines 30-67].

11. Regarding claims 9-14:

Art Unit: 2177

further comprising the step of computing the relevance of said records ... wherein said list of responsive records is sorted according to record name ... citation ... date ... record author ... relevance of records [Barr et al. Figure 5].

12. The limitations of apparatus claims 21-24, 26-39 parallel method claims 1-4 and 6-15 therefore they are rejected under the same rationale.

13. The limitations of claims 50-55, 58-59, 62-67, 71 and 74-75, have been addressed above except for the following: wherein said content elements include paragraphs and means for identifying a most relevant document and an algorithm [note Barr et al. figure 5, 5A, 5B, col. 23 line 10 through col. 24 line 55].

14. Regarding claims 56, 57, 60 and 61 Barr et al. teaches a method for displaying records responsive to a database query on a screen where the records are characterized by having identifiers and content elements [note abstract; figure 2, 3, 4A, col. 22 lines 10-37; note. Barr et al. teaches content elements with identifiers see column 14 lines 29-51]. Although Barr et al. teaches at least two panels (i.e. windows) to view the query [col. 22 lines 31-44]; he does not teach specify simultaneous display within panels. **Jones et al.** teaches simultaneously display of a page image in which the story appears side by side in another panel [abstract, figure 6, 8, col. 8 lines 19-35]. It



Art Unit: 2177

would have been obvious to one of ordinary skill at the time of the invention to have combined Mike et al. with Barr et al. because Mike et al's ability simultaneously display a list of items and there content would provide the user with better viewing of the retrieval result and it's equivalent content.

***Allowable Subject Matter***

15. Claims 16-20 and 40-49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

16. Applicant's arguments with respect to claims 1-4, 6-24, 26-30, 34-67 and 71-75 have been considered but are moot in view of the new ground(s) of rejection. Applicant argued in the response that Mikke does not teach a display of content element with a list of identifiers. In response to Applicant's argument the rejection citing Mikke has been dropped. Barr teaches a display of a list and bibliographical information (i.e. content), note citations supra. Applicant's arguments concerning claims 16-20 and 40-49 are convincing, however a rejection under 35 USC 112 second has been cited. The term said responsive records appears to lack proper antecedent basis.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hobbs. US Patent 6,523,022 B1

Rivette et al. US Patent 5,809,318

Knight et al. US Patent 6,721,748 B1

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/707,910  
Art Unit: 2177

Page 3

Greta Robinson  
Primary Examiner  
June 7, 2004



**GRETA ROBINSON**  
**PRIMARY EXAMINER**